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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,509	07/30/2003	Kazunori Taniguchi	P/3541-38	7893
2352 7590 07/24/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER NGUYEN, TUAN VAN	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 07/24/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,509

Applicant(s)

TANIGUCHI ET AL.

Examiner

Tuan V. Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 17-24, 27-33 and 38 is/are rejected.
- 7) ☒ Claim(s) 6-16, 25, 26 and 34-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's arguments filed on June 07, 2007 with respect to the rejection under 35 U.S.C. § 102(b) as being anticipated by Zvenyatsky (US 5,383,888) have been fully considered but they are moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 3731

4. **Claims 1-2, 33 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Zvenyatsky et al. (U.S. 5,383,888) in view of Klieman et al (US 5,827,323).**

5. Referring to **claims 1-2, 33 and 38**, Zvenyatsky discloses (see Figs. 1-7) a surgical instrument 10 comprising:

an insertion section 18 having a distal end portion 28 and a proximal end portion 12, the insertion section comprising first driving rod 78 and a flexible cable 58 which are disposed side by side and each of which has a distal end portion and a proximal end portion; a pair of jaws 30,32 disposed in the distal end portion of the insertion section;

a support 22 which pivotally supports at least one of the pair of jaws 30,32 to be relatively opened/closed;

a yoke 56 or sliding member, which includes camming pin 55, for providing axial movement and support of the at least one of the pair of jaw, wherein the yoke 56 or sliding member being pivotally supported on the distal end portion of the connecting rod 94; since the applicant fails to explicitly discloses in claim 1 that the sliding member is being directly connected or support on the distal end portion of the connecting rod, therefore, the yoke 56 read on this limitation.

a connecting rod 94 having a distal end portion and a proximal end portion, the sliding member being pivotally supported on the distal end portion of the connecting rod to open/close the pair of jaws, and the distal end portion of the first driving rod being pivotally supported on the proximal end portion of the connecting

Art Unit: 3731

rod; a rotation mechanism that is the distal portion of tubular portion 20, which rotatably supports the support 22 on the distal end portion of the insertion section, and pivotally supports the support 22 on the distal end portion of the flexible cable 58 in a state of being offset with respect to a center axis of the support;

and an operation section 12 disposed in the proximal end portion of the insertion section 18, which pivotally supports the proximal end portions of the first and second driving rods, when the operation section is opened/closed of handle 12 and rotated switch 112, 114, an opening/closing force by the opening/closing operation being transmitted from the proximal end portion to the distal end portion of the first driving rod to slide the sliding member on the support through the connecting rod thereby opening/closing the pair of jaws, and a rotating force by the rotation operation being transmitted from the proximal end portion to the distal end portion of the second driving rod to apply a rotational force on the support to rotate the support on the distal end portion of the insertion section, thereby rotating the pair of jaws with respect to the insertion section relatively (see col. 4, line 24 to col. 6, line 40). Zvenyatsky discloses the invention substantially as claimed except for the second driving rod.

6. Still referring to **claims 1-2, 33 and 38**, however, Klieman discloses a endoscopic instrument (see Figs. 1 and 2B-3B) comprising, among other things, first elongated stainless steel wire member 32 and second elongated stainless steel wire member 34 for pushing and pulling thereby opening and closing of the jaws 40 and 44 (see col. 7, lines 45-59). Therefore, it would have been obvious matter of design choice

Art Unit: 3731

to one of ordinary skill in the art to replace the cable 58 with a stainless steel wire as suggested by Klieman because such replacement will not change the design intended, safety and efficacy of the device.

7. **Claims 3-5, 17-24, 27-33 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zvenyatsky et al. in view of Klieman further in view of Forman (U.S. 5,275,608).**
8. Referring to claims 3-5, 17-20, 23-24, 27-30, 33 and 38, the modified device of Zvenyatsky discloses the invention substantially as claimed except for the connecting rod is made of stainless steel, pair of jaw, the sliding members has conductivity and a connector pin which supplies high-frequency power is electrically connected to at least one of the first driving rod, the connecting rod, the sliding member and the pair of jaw.
9. Still referring to claims 3-5, 17-20, 23-24, 27-30, 33 and 38, however, Forman discloses (see Figs. 1A-3) a surgical tool can be connected to energy supply such as laser knives, electric or laser cauterizing apparatus, and fiber optic connection 19 is provided (see col. 3, lines 50-57). Furthermore Forman discloses the instrument 10 also having control member 14 to control the head 12 (see col. 3, line 35 to col. 5, line 55). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to incorporate the connection pin, and material for electrical conduction as disclosed by Forman to incorporate into the modified device of Zvenyatsky because this will further utilizing the device of Zvenyatsky as suggested by Forman. With respect to

Art Unit: 3731

stainless steel material. Here it is noted that the material is old and well known in the art.

10. Referring to **claims 20-22 and 30-32**, the modified device of Zvenyatsky discloses the invention substantially as claimed except for the insulating sheath wherein the distal tip portion of the sheath having an angle or bevel shape. However, Klieman discloses (see Figs. 1 and 2A) it is old and well known in the art the insulating sheath 10 having a bevel shape 23 for preventing the proximal portion of the pair of jaw 33, 35 from engaging tissue during a surgical procedure (see col. 5, lines 55-65 and col. 7, lines 60-68). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made by the applicant to incorporate the bevel shape at the distal portion of the insulating sheath as disclosed by Klieman to incorporate into the modified device of Zvenyatsky in order to gain the advantage as suggested by Klieman.

Allowable Subject Matter

11. Claims 6-16, 25-26 and 34-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Art Unit: 3731

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, AnhTuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
July 11, 2007


ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

7/20/07.